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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP			EXAMINER	
STEVEN M. GREENBERG			STRODER, CARRIE A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/572,990	<b>Applicant(s)</b> BRUCHLOS ET AL.
	<b>Examiner</b> CARRIE A. STRODER	<b>Art Unit</b> 3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 March 2006.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 14,21,28 and 35-53 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 14,21,28 and 35-53 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 March 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 23 March 2006

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date: \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on 23 March 2006, wherein:

Claims 14, 21, 28, and 35-53 are currently pending; and claims 1-13, 15-20, 22-27, and 29-34 are cancelled.

***Information Disclosure Statement***

1. The information disclosure statement (IDS) was submitted on 23 March 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. However, two references are lined out, as the examiner was unable to locate the references. US 20030121049 is listed as being invented by Yurt, et al., but the IDS states it was invented by Banerjee et al. and includes a different filing date. US 2003061404 was not found.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 21 and 42-47 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. Claim 21 includes several modules. It is unclear what is meant by a "module". A module may be interpreted as software or a broad range of devices.

**3. Claims 21 and 42-47 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claim 35** recites the limitation "the request" in the first limitation. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 14, 35, 38, and 40-41 are rejected under 35 U.S.C. § 101** because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the "machine or-transformation test". *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the

claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

Claims 14, 35, 38, and 40-41 do not include a transformation of a specific article; therefore, there must be a tie to a specific machine. However, claims 14, 35, 38, and 40-41, do not include the required tie to a particular machine or apparatus and thus are directed to nonstatutory subject matter. Although the claims state in the preamble that the method is "computer-implemented," Examiner gives little weight to the preamble, as it is not positively recited in the claim, which is necessary to tie the machine to the process. There must be a tie to a particular machine in the body of the claim, even if

that tie is implicit, as, for example, in claim 37, which states that "...data is processed within header fields of a web service request."

**Claims 21 and 42-47 are rejected under 35 U.S.C. § 101**

because the claimed invention is directed to non-statutory subject matter. Although claim 21 states in the preamble that it is directed to a system, the elements of the claim are all directed to various types of "modules". As above, the preamble receives little patentable weight. A module may be interpreted as software per se, which is not patentable subject matter. SEE MPEP 2106.01.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 14, 21, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Dan et al. (US 6148290).**

**Referring to claims 14 and 28:**

Dan teaches

creating said contract data comprising contract selection parameters for selecting at least one service contract out of said plurality of contracts (col. 7, lines 24-47; "This registration preferably includes storing of a service contract identification number, information regarding the service contract and the service contract itself.");

including said contract data into a request for said service (col. 7, line 24 thru col. 8, lines 20; "...in step 720, the contract enforcement code is generated and integrated with the service implementation code for enabling actual runtime invocation. FIG. 8 illustrates the use of the contract enforcement code during runtime, according to an embodiment of the present invention. In step 800, an external request (or message, or document) arrives at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction...");

issuing said request for said service (col. 7, line 24 thru col. 8, lines 20; "In step 800, an external request (or message, or document) arrives at a particular enforcement code component.

The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction..."); and

receiving the service according to said selection (col. 7, line 24 thru col. 8, lines 20; "...the contract enforcement code invokes, in step 820, an appropriate application method (or program). After the appropriate service implementation logic is executed to provide this service, a response may be generated").

Furthermore, "contract selection parameters for selecting at least one service contract out of said plurality of contracts" is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S.

175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the type of data created can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data.

The subjective interpretation of the data does not patentably distinguish the claimed invention.

**Referring to claim 21:**

Dan teaches

a contract data module for creating said contract data comprising contract selection parameters for selecting at least one service contract out of said plurality of contracts (col. 7, lines 24-47; "This registration preferably includes storing of a service contract identification number, information regarding the service contract and the service contract itself.");

a request population module for including said contract data into a request for said service (col. 7, line 24 thru col. 8, lines 20; "...in step 720, the contract enforcement code is generated and integrated with the service implementation code for enabling actual runtime invocation. FIG. 8 illustrates the use of the contract enforcement code during runtime, according to an embodiment of the present invention. In step 800, an external request (or message, or document) arrives at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received),

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and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction...");

a request issuance module for issuing said request for said service (col. 7, line 24 thru col. 8, lines 20; "In step 800, an external request (or message, or document) arrives at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction..."); and

a receiving module for receiving the service according to said selection (col. 7, line 24 thru col. 8, lines 20; "...the contract enforcement code invokes, in step 820, an appropriate application method (or program). After the appropriate service implementation logic is executed to provide this service, a response may be generated.").

Furthermore, "contract selection parameters for selecting at least one service contract out of said plurality of contracts" is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the type of data created can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Further, "for creating said contract data comprising contract selection parameters for selecting at least one service contract out of said plurality of contracts," "for including said contract data into a request for said service," "for issuing said request for said service via network," and "for receiving the service according to said selection" are statements of intended use. Statements of intended use do not limit the scope of a claim or claim limitation. See MPEP 2106.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 35, 36, 40, 42, 46, 48, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US 6148290).**

***Referring to claim 35:***

Dan teaches

receiving said contract data included in the request with which the service is requested, wherein said contract data comprises contract selection parameters for selecting at least one service contract out of said plurality of contracts (col. 7, line 24 thru col. 8, lines 20; "...in step 720, the contract enforcement code is generated and integrated with the service implementation code for enabling actual runtime invocation. FIG. 8 illustrates the use of the contract enforcement code during runtime, according to an embodiment of the present invention. In step 800, an external request (or message, or document) arrives

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at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction...");

evaluating said contract selection parameters (col. 7, line 24 thru col. 8, lines 20; "The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction...");

selecting one particular contract according to said evaluation and further selection logic (col. 7, line 24 thru col. 8, lines 20; "This registration preferably includes storing of a service contract identification number, information regarding the service contract, and the service contract itself" and "The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state, and the interaction history of the service (e.g., requests and responses received), and whether such a request (or

message, or document) is acceptable from the specific requester as per the rules of interaction..." imply that the particular contract is selected according to said evaluation and further selection logic); and

providing the service according to said contract (col. 7, line 24 thru col. 8, lines 20; "...the contract enforcement code invokes, in step 820, an appropriate application method (or program). After the appropriate service implementation logic is executed to provide this service, a response may be generated.").

**Referring to claims 36, 42, and 48:**

Dan teaches wherein said contract data is processed via software interfaces adapted to comprise said contract data, said interfaces comprising respective definitions of the transport protocol in use, of the messaging protocol in use and on an associated port type in use (col. 6, lines 38-61; "The client/requester logic implementation 528 executing in the client engine 516, makes its service requests via an interface 530 which is a standard programming interface identifying the types of requests for service which can be made for the service provided by the application 500...For example, enforcement code 512, upon receiving a request to be sent from the application 526, can log the request (noting time and content), number the

request for correlation to an anticipated response, provide a signing function, include a timer function and notification in event of timeout and pass the request by a chosen protocol." and where it would have been obvious to a person having ordinary skill in the art at the time of the invention to include the protocols and ports required to communicate since communication takes place).

Further, claim limitations that employ phrases of the type "adapted to," "capable of," or "for" doing something are typical of claim limitations which may not distinguish over prior art. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to do so.

**Referring to claims 40, 46, and 52:**

Dan teaches wherein multiple contract selection parameters are combined in a single service request (col. 7, line 24 thru col. 8, line 20; "The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service..." and where "rules" implies the combination of multiple contract selection parameters in a single service request).

5. **Claims 37-39, 43-45, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US 6148290), in**

**view of "SOAP Version 1.2 part 1: Messaging Framework", W3C, 2 October 2001 (hereinafter referred to as "SOAP").**

**Referring to claims 37, 43, and 49:**

Dan does not teach; however, SOAP teaches wherein said contract data is processed within header fields of a web service request (Section 4.2.1).

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Dan as taught by SOAP because this would allow for the exchange of information in a decentralized, distributed environment (see Abstract of SOAP reference).

**Referring to claims 38, 44, and 50:**

Dan does not teach; however, SOAP teaches wherein said contract data is processed as a part of the endpoint specification of a respective service request (Section 4.2.3).

**Referring to claims 39, 45, and 51:**

Dan does not teach; however, SOAP teaches wherein said contract selection parameters are transported in a SOAP message conforming to the SOAP standard (Section 1; "SOAP version 1.2 provides a simple and lightweight mechanism for exchanging structured and typed information between peers in a decentralized, distributed environment using XML").

6. **Claims 41, 47, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US 6148290), in view of Lamb et al. (US 20050198111).**

**Referring to claims 41, 47, and 52:**

Dan does not teach; however, Lamb teaches wherein said contract selection parameters comprise meta-data identifying a particular contract (paragraph 96; "A format output bundle activity 1526 will hold all conditioned events for a determined amount of time, sort them by date, and bundle all of the conditioned event objects by contract clause ID and add any metadata needed to identify the bundle." implies that metadata may be used to identify a contract).

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Dan as taught by Lamb because this would assist in identifying the appropriate contract.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/  
Examiner, Art Unit 3689

/Janice A. Mooneyham/  
Supervisory Patent Examiner, Art Unit 3689